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TECHNOLOGY CENTER 2100

In re Application of: Chen, et al.
Application No. 09/702,289
Attorney Docket No. TRNDPOO4
Filed: 10/30/2000
For: TRACKING AND REPORTING OF COMPUTER VIRUS INFORMATION

DECISION ON PETITION FOR SUPERVISORY REVIEW UNDER *37 CFR §1.181*

This is a decision on the petition under 37 CFR § 1.181, filed September 6, 2005, requesting the Commissioner to invoke his supervisory authority and withdraw the finality of the final Office action mailed May 4, 2005.

The petition is **GRANTED**.

RECENT PROSECUTION HISTORY

(1) On September 7, 2004, a non-final Office action, treating pending claims 1-22, was mailed.

(2) On December 7, 2004, a response to the non-final Office action, in which amendments to the pending claims, was filed. Note, claims 1, 11, 12 and 22 were amended.

(3) On May 4, 2005, a final Office action, treating pending claims 1- 22, was mailed.

(4) On August 18, 2005, a reply after final rejection was filed requesting reconsideration of the finality of the May 4, 2005 Office action under MPEP 706.07(d).

(6) On August 25, 2005, an interview summary was mailed (corresponding to the August 17, 2005 telephone interview). The finality of the previous Office action was discussed.

(7) On September 6, 2005, a notice of Appeal was filed.

(8) On September 6, 2005, the instant petition was filed.

(9) On September 7, 2005, an advisory action was mailed maintaining the finality of the previous Office action.

RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests the withdrawal of the finality of the May 4, 2005 office action. Specifically, Applicant maintains that the 35 USC 103 rejection, made in the final Office action, are in fact new grounds of rejection not necessitated by the amendment.

ANALYSIS

A non-final Office action was issued on September 7, 2004, including a rejection of claims 1-22 under 35 USC 103(a) as unpatentable over Hailpern et al. ('937) in view of Trcka ('345). An amendment and response to the first Office action was timely filed and received in the Patent and Trademark Office on December 7, 2004. In the amendment filed December 7, 2004, and with particular attention to (independent) claim 12, it is noted that the claim was amended on line 10, to include the phrase ***--information from said client computers--*** after "the scan log". In the final Office action mailed May 4, 2005, the Examiner rejected claims 1-22 under Hailpern et al ('937) and further in view of Trcka et al. ('345) and Tso et al. ('803). Thus, the final Office action of May 4, 2005 introduces a new reference, Tso et al. ('803) and a new grounds of rejection. The amended language of claim 12 (identified above) was held by the Examiner as necessitating the new grounds of rejection presented in the final Office action (see "conclusion" on page 14 thereof).

In consideration of petitioner's remarks and in reviewing the **original recitation** found in claim 12, in particular on lines 7-13 thereof, the following recitations are noted "generating a scan log ***from each scanned client computer*** and sending the scan log back ... ***on each client computer***" and "processing ***the scan log information*** ...". Thus, the amendment recitation, i.e. the step of "receiving the scan log information from said client computers .... ", taken in context within the claim, finds support (and antecedent basis) in the original claim language found in claim 12.

As such, this represents a new ground(s) of rejection. As per MPEP §706.07 (d), a request for reconsideration for withdrawal of the finality of the Office action of May 4, 2005 (as premature) occurred in Applicant's remarks with the after final response (see page 2 thereof) filed on August 18, 2005. The examiner issued an advisory action on August 25, 2005, which denied the request by maintaining the finality of the last Office action.

The relevant sections of the M.P.E.P. are set forth below:

MPEP § 706.07(a) states in part that:
Under present practice, second or any subsequent action on the merits shall be made final, except where the examiner introduces a new ground of rejection ***not necessitated*** by amendment of the application by the applicant, whether or not the prior art is already of record. Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will ***not be made final*** if it includes a rejection, on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

MPEP § 706.07(d) states in part that:
If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

MPEP § 706.07(e) states in part that:
When a final rejection is withdrawn, all amendments filed after the final rejection are

ordinarily entered.

CONCLUSION

A review of the file record indicates that the new ground(s) of rejection with respect to **at least** claim 12 under 35 USC 103(a), in the final Office action of May 4, 2005 was not necessitated by the new limitations and/or amendment presented on December 17, 2004. Thus, it is improper under current Office practice to make the May 4, 2005 Office action final as provided for under MPEP § 706.07(a).

For the above stated reasons, the petition to withdraw the finality of the final Office action of May 4, 2005 is **GRANTED**.

The application file is being forwarded to the tech. support staff to **WITHDRAW** the finality of the previous Office action and to **ENTER** the response filed August 18, 2005. The file will then be forwarded to the Examiner for appropriate action on the merits and prompt consideration of the response.

Any inquiries related to this decision may be directed to Specials Program Examiner Brian Johnson at (571) 272-3595.

Jack Harvey, Director
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